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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,902	11/24/2003	Alan L. Billings	930034-2041	5301
20/999 7590 07/14/2009 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151				
EXAMINER				
AFTERGUT, JEFF H				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
07/14/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/720,902

**Applicant(s)**

BILLINGS ET AL.

**Examiner**

Jeff H. Aftergut

**Art Unit**

1791

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 9-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8 and 16-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-6, 8, and 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Billings (US 6470944) in view of Hansen (US 2002/0102894) and McGahern et al (US 6428874) for the same reasons as expressed in paragraph 2 of the Office action dated January 27, 2009 optionally further taken with EP 877,119 (newly cited) and/or EP 950,508 (newly cited).

The reference to Billings suggested that those skilled in the art would have provided a coating upon the batt which was needled into the base fabric about the exterior of the belt assembly wherein the coating preferably impregnated the base fabric but alternatively was provided as a separate distinct layer on the outside of the base structure (column 4, lines 42-50 "Complete impregnation of the needled structure 52 is preferred rather than a distinct layer on the outside 58 of the base structure."). Clearly, it was known at the time the invention was made to employ a coating which was a distinct layer on the surface of the base layer (albeit not preferred). As it was known to provide the coating as a distinct layer as evidenced by Billings, it would have been obvious to provide the same in the belt of Billings as modified by Hansen and McGahern et al for the reasons expressed above.

To further evidence that those skilled in the art of a compression compliant belt which pressed against a rigid roller in the art would have understood that a coating on the surface of the base fabric which did not completely impregnate the base fabric the

reference to EP '119 suggested that one skilled in the art would have provided the coating on the exterior of the belt on the contacting surface of the belt between the belt and the hard press roller in order to facilitate a uniform pressure pulse as it passes with the paper web through the nip. The degree of penetration is controlled as a function of the nonwoven batt which was used as well as the viscosity of the coating material. One skilled in the art would have determined the degree of penetration of the coating. The reference to EP '119 clearly evidenced that those skilled in the art would have known to employ a coating on the base wherein the coating was either a distinct layer, only partially impregnated the base, or completely impregnated the base. One skilled in the art would have determined which degree of penetration was needed based upon one's desired end characteristics one wished to attain for the endless belt. Note that the base layer has a batt needled thereto and that the coating was applied to the side having the batt disposed thereon.

EP '508 suggested that it was known at the time the invention was made to employ a distinct layer of a resin coating on the exterior of a base fabric which has a batt of fibers needled therein. The reference taught that the coating was applied to the fabric in order to facilitate the frictional gripping of the belt with the corrugated paper material in the device therein. Clearly, to provide the coating as a distinct layer on the surface of the fabric base for this purpose would have been obvious in Billings as one need only provide the distinct layer on the surface to improve the contact between the paper material and the fabric. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a coating on the corrugated belt

material (as clearly suggested by Billings et al) wherein the coating formed a distinct layer on the surface of the base fabric as suggested was known by Billings et al and was further evidenced as known in such belt structures as suggested by the teachings of EP 877,119 and/or EP 950508 in the system for corrugating a web of material wherein the belting included grooves therein in accordance with the teachings of a Hansen and McGahern.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-6, 8 and 16-23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,470,944 in view of McGahern et al and Hansen for the same reasons as expressed in

paragraph 4 of the Office action dated January 27, 2009 further taken with EP 877119 (newly cited) and optionally EP 950508 (newly cited).

US Patent '944 taught the impregnation of the base structure in the operation in the claimed invention. However, those skilled in the art of belt manufacture would have understood that complete impregnation was not needed to accomplish the desired end results in the finished belt assembly. This is particularly true in light of the teachings of EP '119 who applied a coating upon an endless belt of a structure similar in nature to that of US Patent '944 whereby one was able to achieve a uniform pressure pulse across the width of the belt as the belt was used to press a paper against a rigid drum. The belt included a base which included a needled batt therein. One need only apply the coating as a distinct layer on the surface of the belt rather than completely impregnate the same in order to achieve the desired properties in the finished belt. Incomplete impregnation would have saved upon the amount of impregnating material necessary to make the belt while achieving the same end product having similar desired end properties and thus one skilled in the art would have been motivated to perform such incomplete impregnation. the reference to EP '508 suggested that those skilled in the art would have understood that a distinct coating applied upon the surface of an endless belt used in a corrugation operation would have been known to those skilled in the art as such a distinct layer provided one with the ability to retain the web of corrugated material better on the surface of the belt (it increased the friction bearing characteristics of the belt). It would have been obvious to those of ordinary skill in the art at the time the invention was made not only to provide the needled base assembly with a coating but such a

coating would have been employed to provide a distinct layer on the belt as suggested by EP 877119 and EP 950508 wherein the outer surface of the belt was provided with grooves therein as suggested by McGahern and Hansen in the belt assembly of US Patent 6,470,944.

***Election/Restrictions***

5. Claims 7 and 9-15 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 27, 2006.

***Response to Arguments***

6. Applicant's arguments with respect to claims 1-6, 8, and 16-23 have been considered but are moot in view of the new ground(s) of rejection.

The applicant essentially argues that Billings requires complete impregnation of the belt base and thus the reference did not teach or suggest the formation of a distinct layer with the coating operation wherein the base was left essentially unimpregnated. This has not been found to be persuasive. As noted above, the reference to Billings clearly preferred to provide complete impregnation, however the reference taught that those skilled in the art at the time the invention was made would have known to incorporate a distinct layer on the surface of the belt as an alternative to complete impregnation, see column 4, lines 42-50. More specifically, the reference expressly stated:

"Complete impregnation of the needled base structure 52 is preferred rather than a distinct layer on the outside 58 of the base structure."

The reference therefore clearly suggested that it was known at the time the invention was made to provide a distinct layer on the surface of the belt with the coating rather than completely impregnating the same (albeit a non-preferred embodiment).

Additionally, the newly cited references to EP '119 and EP '508 clearly suggested that those skilled in the art would have understood that the coating applied about the exterior surface and onto the batt would have in fact formed a distinct layer on the surface of the belt and such would have had the advantage of using less polymeric material in the assembly for example while achieving the same desired properties in the finished belt and thus such would have been performed in the operation to achieve the belt of the prior art. Applicant's arguments have not been found to be persuasive.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Aftergut whose telephone number is 571-272-1212. The examiner can normally be reached on Monday-Friday 7:30-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeff H. Aftergut/  
Primary Examiner  
Art Unit 1791

JHA  
July 8, 2009